

REMARKS

Applicant was requested to make a restriction/election requirement in the above application between the following groups:

- I. Claims 1-12 and 17-26, classified in class 148, subclass 243;
- II. Claims 13-14, classified in class 106, subclass 14.41;
- III. Claims 15-16 and 27-28, classified in class 106, subclass 14.05; and
- IV. Claims 29-36, classified in class 524, subclass 588.

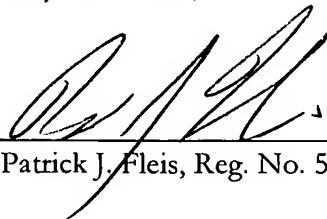
Applicant elects the claims of Group I, namely claims 1-12 and 17-26. However, Applicant respectfully traverses the Examiner's Restriction Requirement, and in the alternative, requests a modification of the requirement so that Groups I, II, and III are combined. For the reasons detailed below, it is apparent that the subject matter of these three groups is interrelated and merits examination in a single application.

The present invention, as noted in groups I, II, and III, is related to a corrosion inhibiting composition for application to a metal substrate, and related methods of using the corrosion inhibiting composition. The Examiner has stated as much in the restriction requirement, citing that groups II and III are related, as are groups III and I.

Furthermore, the stated groups II and III are in almost identical subclasses. In fact group II is an indented subclass of group III. A search of claims in group III would necessarily include a search of the subclass listed in group II. As stated in the MPEP, "[i]f the search and examination of ... the claims in an application can be made without serious burden, the examiner **must** examine them on the merits, even though they include claims to independent or distinct inventions." MPEP 803 (emphasis added). Searching Group II would not be a serious burden when searching for Group III, as it would necessarily be required to be searched. Furthermore, when searching for the subclass in Group II and Group III, the class and subclass of Group I are directed to be cross-referenced and searched. It would be necessary to search Group I when searching for Group II or III. As such, it would not be a serious burden on the Examiner to search Group I when searching for Groups II and III, and the examiner must examine the claims of Group I when searching for the claims of Groups II and III.

Accordingly, Applicant requests that Groups I, II, and III be combined and claims 1-28 be examined. Currently, Applicant has withdrawn claims 13-16 and 27-36 from the application, but requests that withdrawal of claims 13-16 and 27-28 be allowed to be removed, as examination of these claims can be made without a serious burden being imposed on the Examiner.

Respectfully Submitted,

By 

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